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SEP 30 2009
OFFICE OF PETITIONS

In re Application of :
Miroslaw Z. Bober :
Application No. 09/786,352 : ON APPLICATION FOR
Filed: March 13, 2001 : PATENT TERM ADJUSTMENT
Atty Docket No. 1906-0120PUS1 :

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR § 1.705(d) filed July 17, 2009, which is properly treated under 37 CFR 1.705(b). Applicant submits that the correct patent term adjustment to be indicated on the patent is one thousand two hundred and ninety-two (1,292) days, not three hundred fifteen (315) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant requests this correction, in part, on the basis that the Office will take in excess of three years to issue this patent.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is DISMISSED as PREMATURE.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

It is noted that any period of adjustment will be entered in light of 35 U.S.C. 154(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including -

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

It is further noted that a Request for Continued Examination (RCE) was filed in this application on December 21, 2006.

To the extent that applicants otherwise requests reconsideration of the patent term adjustment at the time of the mailing of the notice of allowance, the application for patent term adjustment is DISMISSED.

On April 17, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the initial patent term adjustment to date is 315 days. Applicants timely filed the instant application for patent term adjustment².

Applicant asserts that:

...the U.S. Patent and Trademark Office has incorrectly applied credit days for failure to respond to the Notice of Appeal filed May 19, 2008. The U.S. Patent and Trademark Office is not actually required to respond to a Notice of Appeal until an Appeal Brief has been filed. Because the rejection on appeal was successfully withdrawn and a new Office action was issued, the applicant is actually due credit days for a successful appeal.

Excerpt taken from Request for Reconsideration of Patent Term Adjustment, filed July 17, 2009, p. 2.

A review of the record reveals that the period of adjustment, pursuant to 37 CFR 1.703(a)(3)³ was properly calculated based on

² The issue fee was paid on July 17, 2009. Accordingly, applicant timely filed the instant request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(b) with the payment of the fee set forth in 37 CFR 1.18(e).

³ 37 CFR 1.703(a)(3) states that:

(a) The period of adjustment under § 1.702(a) is the sum of the following periods:

(3) The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply

the failure of the Office to respond to the reply in compliance with § 1.113(c), the notice of appeal filed May 18, 2008, until the mailing of the non-final Office action, November 17, 2008, four months and 59 days later. Accordingly, the period of adjustment of 59 days will remain.

Further, a review of the application history reveals that applicants are not entitled to a period of adjustment under 37 CFR 1.703(e)⁴. A decision by a pre-appeal brief conference panel to withdraw the rejections of any, or all, of the claims on appeal is not a decision by a panel of the Board of Patent Appeals and Interferences, and, as such, is not a successful appeal within the meaning of 37 CFR 1.703(e). It is further noted that no decision was ever rendered in favor of applicants by the Board of Patent Appeals and Interferences, or a Federal court in appeal under 35 U.S.C. 141, or a civil action under 35 U.S.C. 145.

In view thereof, the initial determination of patent term adjustment at the time of the mailing of the notice of allowance remains 315 days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

in compliance with § 1.113(c) was filed and ending on the date of mailing of either an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

⁴ 37 CFR 1.703(e) states that:

(e) The period of adjustment under § 1.702(e) is the sum of the number of days, if any, in the period beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and § 41.31 of this title and ending on the date of a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal court in appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.

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